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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,406 09/09/99 PINEIRO

J T1427

000210  
MERCK AND CO INC  
P O BOX 2000  
RAHWAY NJ 07065-0907

HM12/1213

EXAMINER

LAMBKIN, D

ART UNIT

PAPER NUMBER

1613

4

DATE MAILED:

12/13/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/392,406**

Applicant(s)

**Pineiro et al**

Examiner  
**Deborah Lambkin**

Group Art Unit  
**1613**



☒ Responsive to communication(s) filed on Nov 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16, 18, and 19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-16, 18, and 19 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims drawn to compounds of formula I and their methods of use wherein R1 and R2 do not form a ring, classified in class / subclass numerous depending on the elected species.
  - II. Claims drawn to compounds of formula I and their methods of use wherein R1 and R2 is pyrrolidinyl, classified in class / subclass numerous depending on the elected species.
  - III. Claims drawn to compounds of formula I and their methods of use wherein R1 and R2 is piperidinyl, classified in class / subclass numerous depending on the elected species.
  - IV. Claims drawn to compounds of formula I and their methods of use wherein R1 and R2 is piperazinyl, classified in class / subclass numerous depending on the elected species.
  - V. Claims drawn to compounds of formula I and their methods of use wherein R1 and R2 is morpholinyl, classified in class / subclass numerous depending on the elected species.
  - VI. Claims drawn to compounds of formula II and their methods of use wherein R1 and R2 do not form a ring, classified in class / subclass numerous depending on the elected species.

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- VII. Claims drawn to compounds of formula II and their methods of use wherein R1 and R2 is pyrrolidinyl, classified in class / subclass numerous depending on the elected species.
- VIII. Claims drawn to compounds of the formula II and their methods of use wherein R1 and R2 is piperidinyl, classified in class / subclass numerous depending on the elected species.
- IX. Claims drawn to compounds of formula II and their methods of use wherein R1 and R2 is piperazinyl, classified in class / subclass numerous depending on the elected species.
- X. Claims drawn to compounds of formula II and their methods of use wherein R1 and R2 is morpholinyl, classified in class / subclass numerous depending on the elected species.
- XI. Claims drawn to compounds of formula III and their methods of use wherein R1 and R2 do not form a ring, classified in class / subclass numerous depending on the elected species.
- XII. Claims drawn to compounds of formula III and their methods of use wherein R1 and R2 is pyrrolidinyl, classified in class / subclass numerous depending on the elected species.

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- XIII. Claims drawn to compounds of the formula III and their methods of use wherein R1 and R2 is piperidinyl, classified in class / subclass numerous depending on the elected species.
- XIV. Claims drawn to compounds of formula III and their methods of use wherein R1 and R2 is piperazinyl, classified in class / subclass numerous depending on the elected species.
- XV. Claims drawn to compounds of formula III and their methods of use wherein R1 and R2 is morpholinyl, classified in class / subclass numerous depending on the elected species.
2. The inventions are distinct, each from the other because of the following reasons:
3. They each relate to a separate class of structurally diverse compounds which do not possess a common core nor is said core novel or shown to be essential by itself for the proposed utility, hence a reference anticipating one would not necessarily render the other obvious and to search and examine all the above groups in a single application would place an undue burden on the examiner.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

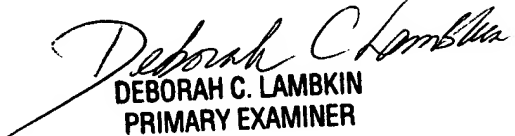
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lambkin whose telephone number is (703) 308-4522.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Dcl406r

  
DEBORAH C. LAMBKIN  
PRIMARY EXAMINER